

S.N. 09/597,960Page 2

REMARKS

Claims 1-3, 5-7 and 9-19 are pending in the application.

Claims 1-3, 5-7 and 9-19 are rejected.

Claims 1, 7, 9-12, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derocher et al. in view of Kikinis et al. U.S. Patent No. 5,822,230. Claims 2-3, 5-6, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derocher et al. in view of Weiss U.S. Patent No. 6,492,975. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Derocher et al. in view of Weiss and Lee U.S. Patent No. 6,392,632. Claims 13-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derocher et al. in view of others. These rejections are respectfully traversed.

It is not clear whether the '103 rejection is based on Derocher et al. U.S. Patent No. 6,304,249 or Derocher et al. U.S. P. 6,476,795 (both of which have been made of record). However, it does not matter, for neither Derocher patent can be used in the '103 rejection.

35 USC §103(c) states that "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

See also MPEP 706.02(I)(1), which states that the provision regarding subject matter under 35 USC 102(e) "applies to all utility, design and plant patent applications filed on or after November 29, 1999."

S.N. 09/597,960Page 3

The subject application was filed on June 20, 2000. Derocher et al. U.S. Patent No. 6,304,249 was filed on Sept. 24, 1999 and issued on Oct. 16, 2001. Derocher et al. U.S. Patent No. 6,476, 795 filed on January 20, 2000 and issued on November 5, 2002.

Both Derocher et al. patents are prior art under subsection (e) of section 102, since the present application was filed after the filing dates but before the issuances of both patents. The two Derocher et al. patents and the present application are assigned to Hewlett-Packard Company. Therefore, the Derocher et al. patents shall not preclude patentability under section 103. Accordingly, the '103 rejections of claims 1-3, 5-7 and 9-19 should be withdrawn.

Weiss is not prior art under 35 U.S.C. The application for the Weiss patent was filed on October 10, 2000, four months after the filing date of the subject application. For this additional reason, the '103 rejections of independent claims 5, 6 and 15 and their dependent claims 2-3, 7, 12-14 and 19 should be withdrawn.

In conclusion, the Derocher et al. patents cannot be used in the '103 rejection of claims 1-3, 5-7 and 9-19, and Weiss is not prior art. Accordingly, claims 1-3, 5-7 and 9-19 should be allowed over the documents made of record.

The examiner is respectfully requested to withdraw the rejections and issue a notice of allowability. If issues remain, the examiner is invited to contact the undersigned to discuss those remaining issues.